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Debra L. Harp

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBRA L. HARP and DENNIS S. HARP

Appeal 2008-0784
Application 10/766,628
Technology Center 3700

Decided: April 17, 2008

Before TERRY J. OWENS, JENNIFER D. BAHR and JOHN C. KERINS,
Administrative Patent Judges.

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Debra L. Harp and Dennis S. Harp (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of Claims 1-6 and 8-20. Prior to this appeal, Claim 7 was canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a firelight reflective system that is intended for use within a fireplace having a firebox with a predetermined interior surface structure. The reflective system comprises at least one light or image reflective material having a viewable surface and a coupling surface. Each of the at least one reflective materials is to be sized to fit within any interior surface structure of the firebox, and each is to be coupled substantially parallel to an interior surface structure of the firebox. In this manner, the reflective system is said to be adapted to provide a three-dimensional view consistent with the interior surface of the firebox.

Claims 1 and 8, reproduced below, are representative of the subject matter on appeal.

1. A firelight reflective system for use within a fireplace having a firebox with a pre-determined interior surface structure, the system comprising

at least one light or image reflective material having a viewable surface and a coupling surface,

each light reflective material measured to substantially fit within, and couple substantially parallel to, any pre-determined interior surface structure of the firebox,

the system adapted to provide a three-dimensional

view consistent with the pre-determined interior surface of the firebox.

8. The firelight reflective system of Claim 3, the coupling surface being fastened to the interior surfaces of the fireplace by heat-resistant adhesive.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Greenspan	US 3,877,802	April 15, 1975
Pledger	US 3,942,879	March 9, 1976
Hiser	US 4,129,114	December 12, 1978
Shumaker	US 4,309,142	January 5, 1982
Fleming	US 4,667,607	May 26, 1987
Kasulis	US 5,469,839	November 28, 1995
Butterfield	GB 2,220,060 A	December 28, 1989
Kawamoto Buddhist Altar Store Ltd.	JP 2003-079507	March 18, 2003

The following rejections are before us for review:

1. Claims 1-6 and 10-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Kasulis patent. In the alternative, Claims 1-6 and 10-20 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of the Kasulis patent.¹

¹ The Examiner's Answer states that these rejections are made in view of Kasulis, as supported by the prior art teachings of Shumaker, Greenspan, Pledger, Hiser, Fleming, and the Butterfield published Great Britain

2. Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Kasulis patent, in view of the Japanese Published Unexamined (Kokai) Patent Application No. 2003-079507 (hereafter JP ‘507).

ISSUES

A first issue raised in this appeal is whether Appellants have shown that the Examiner erred in finding that Claims 1-6 and 8-20 are anticipated by the Kasulis patent. Another issue is whether Appellants have shown that the Examiner erred in concluding that Claims 1-6 and 8-20 are obvious, and therefore unpatentable, over the Kasulis patent. A further issue is whether Appellants have shown that the Examiner erred in determining that Claims 8 and 9 are obvious in view of Kasulis and JP ‘507.

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d

application. (Answer 3). The detailed grounds for rejection, as pointed out by Appellants, contain no indication as to what portions of these additional references are relied on as teaching or suggesting any of the claim elements. Several of these references were previously relied on as evidencing that it was common knowledge that, for a reflective surface, the angle of incidence of a ray of light is equal to its angle of reflection, an element that appeared in previous versions of the claims. At present, the Examiner relies on these additional references at most as evidencing that certain aspects of the Kasulis device (*e.g.*, incident/reflection angle, tempering of glass for high temperature conditions) are inherent if not expressly disclosed, and we will treat the rejection as being based on the teachings of Kasulis alone.

1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF1. The Kasulis patent discloses a firelight reflective system capable of being used in a fireplace or firebox, having a vertical reflective rear panel 76, and two vertical reflective side panels 86, as well as an upper rear panel 78 disposed above rear panel 76, the panels 76 and 78 meeting at an obtuse angle. (Kasulis, Fig. 8; Col. 5, l. 57-Col. 6, l. 8).

FF2. The Kasulis patent illustrates fireplace 96 in broken lines, and provides no discussion or information as to any specific structural or configurational requirements for a fireplace with which the Kasulis reflective system could be used. (*Id.*)

PRINCIPLES OF LAW

Claims on appeal are not to be confined to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). During *ex parte* prosecution, claims must be interpreted as broadly as their terms reasonably allow, since Applicants have the power during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). The broadest reasonable meaning of claim terms will be in accord with their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Anticipation of a claim exists when each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

In *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966), the Supreme Court set out a framework for applying the statutory language of § 103:

[T]he scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”

There is a need for caution in granting a patent based upon a combination of elements found in the prior art. In particular, a patent for a combination which only unites old elements with no change in the respective functions of the elements withdraws what is already known into the field of monopoly and diminishes the resources available to skillful practitioners. *Id.* at 1739.

ANALYSIS

Anticipation rejection of Claims 1-6 and 10-20

Appellant argues these claims collectively as a group, and, therefore, the claims will stand or fall together. We will select Claim 1 as representative of the group for the purposes of this appeal. 37 C.F.R. 41.37(c)(1)(vii) (2007).²

The rejection of the claims relies principally, if not exclusively, on the embodiment in Kasulis illustrated in Figures 8 and 9. Figure 8 in particular shows a reflective system capable of being positioned in a fireplace, with the system having a vertical reflective rear panel 76, two vertical reflective side panels 86, and an upper rear panel 78 disposed above rear panel 76, with the panels 76, 78 meeting or being joined at an obtuse angle. (FF1). The Examiner contends that the rear reflective panel 76 and side reflective panels 86 form a reflective system meeting all of the limitations set forth in Claim 1, including that the panels reflect light, that they are capable of being coupled substantially parallel to interior surfaces of a firebox, and that the

² At the close of the section in Appellants' Brief on Appeal that contains the arguments directed to the patentability of Claim 1, Appellants state that the element claimed in dependent claims 2, 12, and 18, and the element claimed in dependent claim 16, are not disclosed in Kasulis. (Appeal Br. 14). Since these statements do not point out with any specificity the alleged error in the Examiner's contrary finding, the "arguments" amount to nothing more than merely pointing out what the claims recite, and, as such, they will not be regarded as being arguments for the separate patentability of those claims. 37 C.F.R. 41.37(c)(1)(vii) (2007). Even if treated as separate arguments, they are not persuasive that the Examiner's reading of Kasulis is in error.

system is adapted to provide a three-dimensional view consistent with an interior surface of a firebox. (Answer 5, 10, 11).

The Examiner's position also includes threshold contentions directed to claim construction issues. The claim term, "for use within a fireplace", has not been given patentable weight, as, according to the Examiner, this term is found in the preamble and amounts to nothing more than an intended use of the claimed structure.³ (Answer 4). In addition, the Examiner regards the phrase, "measured to substantially fit within, and couple to, one or more interior surfaces of the fireplace"⁴, as a recitation of intended use which fails to impart any positive structural limitation to the claimed system that would distinguish the claimed invention over the prior art of record. (*Id.*).

The Examiner stresses that Claim 1 should thus be interpreted as being directed not to a combination of a firebox and a reflective system, but rather to a reflective system *per se* that is for use in a fireplace. We agree that the phrase, "for use within a fireplace", and the absence in the claim of any positive structural features of a fireplace, result in a claim construction

3

The claim term, "[A] firelight", was also considered to be a non-limiting preamble term. We believe that the term "firelight" should properly be given patentable weight, however, the issues on appeal do not turn on whether this term should or should not be afforded patentable weight.

⁴ The actual claim language is, "measured to substantially fit within, and couple substantially parallel to, any pre-determined interior surface structure of the firebox...". (Appeal Br., Claims Appendix).

which requires only that a reflective system be capable of being used in a fireplace or firebox.

Appellants contend that the Kasulis patent fails to anticipate the subject matter of Claim 1, principally on the basis that Claim 1 requires that *each* light reflective material employed in the claimed reflective system is to be coupled substantially parallel to an interior surface of the firebox. (Appeal Br. 8). That particular arrangement of the light reflective material is further contended to yield a reflective system that has “a three-dimensional view consistent with the pre-determined interior surface of the firebox.” (*Id.*).

Appellants argue that the reflective system disclosed in the Kasulis patent includes one panel of light reflective material 78 that is disposed at an angle relative to vertical reflective panel 76, and that panel 78 is not substantially parallel to an interior surface of the firebox disclosed in Kasulis. (Appeal Br. 8, 9). Appellants further argue that, because panel 78 is not parallel to an interior surface, the Kasulis device also does not provide a three-dimensional view that is consistent with the interior surface of the firebox. (*Id.*).

The claims on appeal are not directed to a combination of a firebox and a reflective system. Appellants’ arguments incorrectly assume that each and every firebox into which the Kasulis system might be placed will have a fully vertical rear wall. However, the Kasulis patent illustrates fireplace 96 in only a schematic representation, and Kasulis imposes no specific

constructional restrictions on the fireplace or firebox with which the reflective system is to be used. (FF2).

The reflective system disclosed in Kasulis is capable of being used in a firebox or fireplace that is constructed with an upper part of the rear wall angled forward. As deployed in such a fireplace, panel 78 of Kasulis would be substantially parallel to the angled rear wall portion. The Kasulis system thus would also, “provide a three-dimensional view that is consistent with the interior surface of the firebox.”⁵ (Appeal Br., Claims Appendix). The Kasulis system in this application would meet all limitations or elements set forth in Claim 1.

Also playing a role in the issue joined by the Examiner and Appellants is the Affidavit (declaration) of Yahvinder Sabharwal, Ph.D., submitted pursuant to 37 C.F.R. § 1.132 during the course of prosecution, and included in Appellants’ Appendix B (Evidence Appendix) to the main Brief on Appeal. Appellants assert that the Affidavit constitutes evidence that the Kasulis system relied on in rejecting the claims on appeal does not meet the claim element calling for, “the system [being] adapted to provide a three-dimensional view consistent with the pre-determined interior surface of the firebox.” (Appeal Br., Claims Appendix). The Affidavit specifically states that,

⁵ Accepting, for the sake of this analysis, that this claim element naturally and necessarily results from a construction in which each of the light reflective materials is coupled substantially parallel to an interior surface of the firebox, a position advanced by Appellants. (Appeal Br. 11).

[T]he Kasulis disclosure teaches the use of mirrors positioned at *angles* to the interior surfaces of the fireplace or firebox, which will create an optical view that is different in perspective from the original three-dimensional construction of the fireplace or firebox. [citations omitted] Any images reflecting off the Kasulis patent surfaces (for example, surfaces 76, 78 in the Kasulis disclosure Figure 8) would necessarily present an elongated optical image of the firelight to a viewer of the Kasulis invention. The present invention, in contrast to the Kasulis disclosure, teaches the positioning of the reflective material to be *substantially parallel* to the interior surfaces of the fireplace or firebox, maintaining an optical view consistent with the predetermined interior surface of the fireplace, firebox, or fire chamber.

Sabharwal Affidavit, ¶10 (emphasis in original).

Appellants have argued that the angled orientation of panel 78 in Kasulis, “will necessarily result in a view which is *not* consistent with the pre-determined interior surface of the fire chamber.” (Appeal Br. 10)(emphasis in original). The passage in the Sabharwal Affidavit, quoted *supra*, is relied upon as evidence supporting this alleged difference between the claimed structure and the structure in Kasulis.

We find that the Affidavit is not persuasive in establishing that such a distinction exists. The Affidavit is founded on the premise that each section of reflective material must be positioned substantially parallel to the interior surfaces of the fireplace or firebox in order to maintain a three-dimensional optical view that is consistent with the predetermined interior surface of the

fireplace, firebox or fire chamber.⁶ (Sabharwal Affidavit, ¶10). The Affidavit states that images reflecting off of surfaces 76, 78 of Kasulis, “would necessarily present an elongated optical image of the firelight to a viewer of the Kasulis invention. (*Id.*). The Affidavit does not, however, take into account that the Kasulis system could indeed be employed in a fireplace configured with an angled upper rear wall, such that each reflective panel is coupled substantially parallel to an interior surface of the fireplace.

Moreover, Dr. Sabharwal’s conclusion directed to optical distortion (elongated optical image) is that such distortion necessarily results from positioning reflective surfaces at varying angles with respect to an object that is to be reflected. Appellants have disclosed embodiments (*see, e.g.*, Figures 2, 4, 5) in which the side walls and the rear wall of the firebox, to which the reflective materials are coupled in a substantially parallel manner, are positioned or joined at obtuse angles.⁷

The Affidavit fails to address and reconcile how the distortion that would necessarily occur in Appellants’ embodiments illustrated in Figures 2 and 5 is distinguishable, in terms of meeting or not meeting the limitation at issue in Claim 1, from the distortion that is said to necessarily occur with

⁶ The Specification nowhere describes or defines what is meant in Claim 1 by, “provid[ing] a three-dimensional view consistent with the pre-determined interior surface of the firebox.” (Appeal Br., Claims Appendix). This limitation was added to Claim 1 during prosecution of the application, there is no corresponding language in the Specification.

⁷ Figures 2 and 5 are front plan views. (Specification, p. 5, ¶[0013], ¶[0016].

panels 76, 78 of the Kasulis system. Again, this appears to be as a result of a failure to recognize that Claim 1 is not directed to a combination of a specific fireplace configuration and an associated reflective system, as well as that the Kasulis system is capable of being employed in a fireplace configured such that all of the Kasulis panels would be coupled in a substantially parallel manner to interiors surfaces of the fireplace.

We therefore find the Affidavit to be unpersuasive in establishing a distinction between the claimed invention and the system disclosed in the Kasulis patent. There being no other persuasive evidence proffered as to this issue, we are not persuaded that the Examiner erred in rejecting the claims as anticipated by Kasulis.

We will affirm the rejection of Claims 1-6 and 10-20 under 35 U.S.C. § 102(b) as anticipated by Kasulis.

Obviousness rejection of Claims 1-6 and 10-20

Claims 1-6 and 10-20 are also rejected, in the alternative, under 35 U.S.C. § 103(a) in view of the Kasulis patent.⁸ Appellants argue that, just as Claim 1 is not anticipated by Kasulis, neither is it rendered obvious by that patent.

⁸ As is the case with the rejection of these claims under 35 U.S.C. § 102(b), the Examiner identifies additional references, but does not appear to rely on any of them in the rejection of Claim 1. Accordingly, we will treat the rejection of the claims under 35 U.S.C. § 103(a) as being over Kasulis only. *See*, fn. 1.

Appellants have not separately argued for the patentability of any claims apart from Claim 1. We have held in the preceding section that we are not persuaded that error was committed in rejecting Claim 1, and Claims 2-6 and 10-20 grouped with Claim 1, as anticipated by Kasulis.

It is well-established that, “anticipation is the epitome of obviousness”. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Following this principle, we will affirm the rejection of Claims 1-6 and 10-20 under 35 U.S.C. § 103(a) in view of Kasulis, for the reasons presented in the preceding section of this decision.

Obviousness rejection of Claims 8 and 9

Claims 8 and 9 stand rejected as being obvious over the Kasulis disclosure, in view of the disclosure in JP ‘507. Appellants do not argue that the reasoning presented is erroneous; rather they assert only that a rejection of these claims under 35 U.S.C. § 103(a) is erroneous as a matter of law.

Appellants’ position is predicated upon the assertion that, “[W]hile a combination of prior art is allowed to support a rejection under Section 103, such a rejection cannot be asserted against dependent claims when the corresponding independent claim is allowed under Section 103.” (Appeal Br. 15). However, in the Final Rejection in this application, as well as in the Examiner’s Answer, Claim 1, from which Claims 8 and 9 depend, *was* rejected under 35 U.S.C. § 103(a). As such, Appellants’ argument is misplaced, in that Claim 1 is not allowed, but is instead rejected, under Section 103(a).

Appellants also argue that, notwithstanding that Claim 1 is rejected under 35 U.S.C. § 103(a) over Kasulis, a rejection of Claims 8 and 9 over Kasulis in view of JP ‘507 is improper because Claim 1 is not rejected on identical grounds. We believe this to be an incorrect position, and that the decisions cited by Appellants in support of this position do not square factually with the present case.

Claim 1, in the Examiner’s view, did not contain any elements or limitations that necessitated that the grounds of rejection include reliance on the JP ‘507 reference as evidence supporting the unpatentability of that claim. We have herein affirmed the Examiner’s decision in this regard.

Claims 8 and 9, in contrast, implicitly include all elements or limitations found in Claim 1, and, *in addition*, include further elements or limitations. Finding that these elements were not identically disclosed or fairly suggested by the Kasulis patent, the Examiner cited the JP ‘507 reference as evidence which, in combination with the teachings in Kasulis, led the Examiner to the conclusion that the subject matter of Claims 8 and 9 would have been obvious to a person of ordinary skill in the art.

This course of action appears to us to be fully consistent with standard examination practice. We are far from persuaded that the rejection of Claims 8 and 9 under 35 U.S.C. § 103(a) in these circumstances is erroneous as a matter of law. We will therefore affirm the rejection.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 1-6 and 10-20 under 35 U.S.C. § 102(b) as lacking novelty over Kasulis.

We also conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 1-6 and 10-20 under 35 U.S.C. § 103(a), as being unpatentable over Kasulis.

We further conclude that Appellants have failed to establish that reversible error exists in the rejection of Claims 8 and 9 under 35 U.S.C. § 103(a), as being unpatentable over Kasulis in view of JP ‘507.

ORDER

The decision of the Examiner to reject Claims 1-6 and 10-20 under 35 U.S.C. § 102(b) is AFFIRMED.

The decision of the Examiner to reject Claims 1-6 and 10-20 under 35 U.S.C. § 103(a) is AFFIRMED.

The decision of the Examiner to reject Claims 8 and 9 under 35 U.S.C. § 103(a) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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Appeal 2008-0784
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